

Telephone: (203) 461-7000
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Walker Digital, LLC**Fax**

To: PATENT EXAMINER P. ELISCA - USPTO **From:** VERONIKA S. LELIEVER

Fax: 703.305.7687

Pages: 15

Phone: 703.305.3987

Date: November 4, 2002

Re: App. Serial No. 09/221,099

Phone: 203-461-7035

☒ Urgent ☒ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

• **Comments:**

DUPLICATE OF

FORMAL RESPONSE FILED SEPTEMBER 9, 2002

Re: Application Serial No. 09/221,099, Attorney Docket No. 98-112
Titled: "PRE-SALE DATA BROADCAST SYSTEM AND METHOD"

Responsive to the Notice of Abandonment, mailed 10.28.02, (see copy attached) for Applicant's failure to timely file a proper reply to the Office letter mailed on March 8, 2002, please find enclosed copy of Transmittal Letter, Combined Amendment & Petition for Extension of Time Under 37 CFR 1.136(a), Assertion of Small Entity Status and Amendment & Response to Non-final Office Action as timely filed on September 9, 2002.

Additionally forwarded is a copy of Return Receipt Postcard clearly indicating receipt of the above referenced documentation by the USPTO time stamp dated September 16, 2002.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being
Facsimile Transmitted to the United States Patent
and Trademark Office (Fax No. 703.305.7687) on
November 4, 2002.

Dated: 11.4.02 By: Veronika S. Leliever

Veronika S. Leliever

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Veronika S. Leliever

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NOV 04 2002

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20531
www.uspto.gov

Pre-Sale Data Broadcast CIP

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/221,099	12/28/1998	JAY S. WALKER	WD2-98-112	5153

23927 7590 10/28/2002

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

COPY

EXAMINER

ELISCA, PIERRE E

ART UNIT

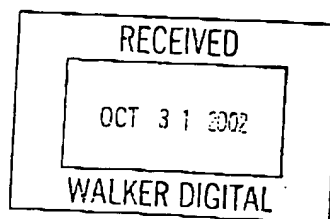
PAPER NUMBER

3621

DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

OFFICIAL



Notice of Abandonment

Application No.

09/221,099

Applicant(s)

Walker et al.

Examiner

Pierre E. Eliase

Art Unit

3621

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on Mar 8, 2002.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted issue fee of \$ _____ is insufficient. A balance of \$ _____ is due.
The issue fee required by 37 CFR 1.18 is \$ _____. The publication fee, if required by 37 CFR 1.18(d) is \$ _____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed new formal drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:



Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

COPY

Veronika S. Leliever
Intellectual Property Department
Walker Digital Management, LLC
Five High Ridge Park
Stamford, CT 06905

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NOV 04 2002

GROUP 3600

Commissioner for Patents:

Date Received:

Applicant: JAY S. WALKER et al.
Serial No.: 09/221,099
Filing Date: December 28, 1998

Commissioner for Patents:

Date Received:

Applicant: JAY S. WALKER et al.
Serial No.: 09/221,099
Filing Date: December 28, 1998
Title: PRE-SALE DATA BROADCAST SYSTEM AND METHOD
(98-112)

Sir:

Please acknowledge receipt of the following papers by stamping the date received on this card and returning the same to the addressee.

- Transmittal Letter, 1 pg. (x2);
- Combined Amendment & Petition for Extension of Time Under 37 CFR (2 pp.) (x2);
- Assertion of Small Entity Status, 1 pg.; and
- Amendment & Response to Non-final Office Action, (4 pp.).

Date mailed: September 9, 2002.



TRANSMITTAL LETTER
 (General - Patent Pending)

 Docket No.
 98-112

In Re Application Of:

JAY S. WALKER et al.

 Serial No.
 09/221,099

 Filing Date
 December 28, 1998

 Examiner
 P. E. Elisca

 Group Art Unit
 2161

Title:

PRE-SALE DATA BROADCAST SYSTEM AND METHOD

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Combined Amendment & Petition for Extension of Time, 2 pp., (x2);
 Assertion of Small Entity Status, 1 pg.;
 Amendment & Response to Non-final Office Action, 4 pp.; and
 Return Receipt Postcard.

OFFICIAL

in the above identified application.

- ☐ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Assistant Commissioner is hereby authorized to charge and credit Deposit Account No. 50-0271 as described below. A duplicate copy of this sheet is enclosed.
- ☒ Charge the amount of \$460.00
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.

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NOV 04 2002

GROUP 3600

Dated: September 9, 2002

Steven M. Santisi
 Attorney for Applicants
 Walker Digital, LLC
 PTO Registration No. 40,157
 203.461.7054/phone
 203.461.7300/fax

Customer No. 22927

Santisi@walkerdigital.com

CC:

I certify that this document and fee is being deposited
 September 9, 2002 with the U.S. Postal Service as
 first class mail under 37 C.F.R. 1.8 and is addressed to the
 Assistant Commissioner for Patents, Washington, D.C.
 20231.

Signature of Person Mailing Correspondence

Veronika S. Leliever

Typed or Printed Name of Person Mailing Correspondence

TRANSMITTAL LETTER
(General - Patent Pending)Docket No.
98-112

In Re Application Of:

JAY S. WALKER et al.

Serial No.

09/221,099

Filing Date

December 28, 1998

Examiner

P. E. Elisca

Group Art Unit

2161

Title:

PRE-SALE DATA BROADCAST SYSTEM AND METHOD

TO THE ASSISTANT COMMISSIONER FOR PATENTS:


Transmitted herewith is:

Combined Amendment & Petition for Extension of Time, 2 pp., (x2);
Assertion of Small Entity Status, 1 pg.;
Amendment & Response to Non-final Office Action, 4 pp.; and
Return Receipt Postcard.

in the above identified application.

- ☐ No additional fee is required.
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Dated: September 9, 2002

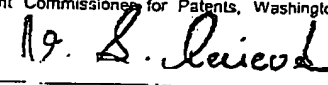

Signature
Steven M. Santisi
Attorney for Applicants
Walker Digital, LLC
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Customer No. 22927

Santisi@walkerdigital.com

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Typed or Printed Name of Person Mailing Correspondence

**COMBINED AMENDMENT & PETITION FOR EXTENSION OF
TIME UNDER 37 CFR 1.136(a) (Small Entity)**Docket No.
98-112

In Re Application Of: JAY S. WALKER et al.

Serial No.
09/221,099Filing Date
December 28, 1998Examiner
Pierre E. EliscaGroup Art Unit
2161

Invention: PRE-SALE DATA BROADCAST SYSTEM AND METHOD

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

This is a combined amendment and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the Office Action of March 8, 2002 in the above-identified application.
Date

The requested extension is as follows (check time period desired):

☐ One month ☐ Two months ☒ Three months ☐ Four months ☐ Five months

from: June 8, 2002 until: September 8, 2002
Date *Date*

A verified statement of small entity status as a small entity under 37 CFR 1.27:

- ☒ is enclosed.
☐ has already been filed in this application.

The fee for the amendment and extension of time has been calculated as shown below:

CLAIMS AS AMENDED

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	12 -	91 =	0	x \$9.00	\$0.00
INDEP. CLAIMS	4 -	23 =	0	x \$42.00	\$0.00
FEE FOR AMENDMENT					\$0.00
FEE FOR EXTENSION OF TIME					\$460.00
TOTAL FEE FOR AMENDMENT AND EXTENSION OF TIME					\$460.00

**COMBINED AMENDMENT & PETITION FOR EXTENSION OF
TIME UNDER 37 CFR 1.136(a) (Small Entity)**Docket No.
98-112

The fee for the amendment and extension of time is to be paid as follows:

- ☐ A check in the amount of \$460.00 for the amendment and extension of time is enclosed.
- ☒ Please charge Deposit Account No. 50-0271 in the amount of \$460.00
A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0271
A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☒ Any patent application processing fees under 37 CFR 1.17.
- ☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-0271 A duplicate copy of this sheet is enclosed.


Signature

Dated: September 9, 2002

Steven M. Santisi
Attorney for Applicants
Walker Digital, LLC
PTO Registration No. 40,157
203.461.7054/phone
203.461.7300/fax

Customer No. 22927
Santisi@walkerdigital.com
cc:

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Assistant Commissioner for Patents, Washington, D.C.
20231.

Signature of Person Mailing Correspondence

Veronika S. Leliever

Typed or Printed Name of Person Mailing Correspondence

**COMBINED AMENDMENT & PETITION FOR EXTENSION OF
TIME UNDER 37 CFR 1.136(a) (Small Entity)**

Docket No.
98-112

In Re Application Of: JAY S. WALKER et al.

Serial No.
09/221,099

Filing Date
December 28, 1998

Examiner
Pierre E. Elisca

Group Art Unit
2161

Invention: PRE-SALE DATA BROADCAST SYSTEM AND METHOD

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

This is a combined amendment and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the Office Action of March 8, 2002 in the above-identified application.

Date

The requested extension is as follows (check time period desired):

☐ One month ☐ Two months ☒ Three months ☐ Four months ☐ Five months

from: June 8, 2002 until: September 8, 2002

Date

Date

A verified statement of small entity status as a small entity under 37 CFR 1.27:

- ☒ is enclosed.
☐ has already been filed in this application.

The fee for the amendment and extension of time has been calculated as shown below:

CLAIMS AS AMENDED

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TOTAL CLAIMS	12 -	91 =	0	x \$9.00	\$0.00
INDEP. CLAIMS	4 -	23 =	0	x \$42.00	\$0.00
FEE FOR AMENDMENT					\$0.00
FEE FOR EXTENSION OF TIME					\$460.00
TOTAL FEE FOR AMENDMENT AND EXTENSION OF TIME					\$460.00

**COMBINED AMENDMENT & PETITION FOR EXTENSION OF
TIME UNDER 37 CFR 1.136(a) (Small Entity)**Docket No.
98-112

The fee for the amendment and extension of time is to be paid as follows:

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- ☒ Please charge Deposit Account No. 50-0271 in the amount of \$460.00.
A duplicate copy of this sheet is enclosed.
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A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☒ Any patent application processing fees under 37 CFR 1.17.
- ☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-0271. A duplicate copy of this sheet is enclosed.

Signature

Dated: September 9, 2002

Steven M. Santisi
Attorney for Applicants
Walker Digital, LLC
PTO Registration No. 40,157
203.461.7054/phone
203.461.7300/fax

Customer No. 22927
Santisi@walkerdigital.com
cc:

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20231.

Signature of Person Mailing Correspondence

Veronika S. Leliever

Typed or Printed Name of Person Mailing Correspondence

Application No. 09/221,099
Attorney Docket No.: 98-112

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: WALKER et al.

) Examiner: P. E. Elisca

Serial No.: 09/221,099

Group Art Unit: 2161

Filing Date: December 28, 1998

) Attorney Docket No: 98-112

Customer No.: 22927

) Notification of Fee Status Change
)

For: PRE-SALE DATA BROADCAST
SYSTEM AND METHOD

Pursuant to 37 CFR § 1.27



Assistant Commissioner for Patents
Washington, D.C. 20231

ASSERTION OF SMALL ENTITY STATUS

Dear Sir:

The assignee of the above-identified application claims small entity status. This notification is made pursuant to 37 CFR §1.27.

If the Examiner has any questions about this status change, the Examiner is invited to contact the undersigned at (203) 461-7054. While no fees are believed due in connection with this paper, please charge any fees that may be required for this paper, or with any other papers filed in connection with this application to Deposit Account No. 50-0271.

September 9, 2002
Date

Respectfully submitted

Steven M. Santisi
Attorney for Applicants
Walker Digital, LLC
Registration No. 40,157
(203) 461-7054 /direct
(203) 461-7300 /fax
santisi@walkerdigital.com

PATENT

Application Serial No. 09/221,099
Attorney Docket No. 98-112

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Walker et al.) Group Art Unit: 2161
Application No.: 09/221,099) Examiner: Elisca, Pierre E.
Filed: December 28, 1998) (703) 305-3987
For: PRE-SALE DATA BROADCAST) (703) 308-9051 /fax
SYSTEM AND METHOD) **RESPONSE to the Non-final**
Customer No. 22927) **Office Action mailed March 8, 2002**
) **(Paper No. 16)**
) Attorney Docket No. 98-112
)
)
)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope with sufficient postage and addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on September 9, 2002.

Dated: September 9, 2002 By:

Veronika S. Leliever

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Non-Final Office Action mailed March 8, 2002, (Paper No. 16), entry of the following amendments into and consideration of the following remarks regarding the above-identified application are respectfully requested.

PATENT

Application Serial No. 09/221,099
Attorney Docket No. 98-112

R E M A R K S

Claims 17 to 26, 80, 86 to 87 are pending in the present application.

Claims 17, 80, 86, 87 are independent.

Section 103(a) Rejections

All claims are rejected as being unpatentable over a combination of Fraser (WO 97/08638), West (U.S. Patent No. 5,845,259) and now Jones (U.S. Patent No. 5,832,458). Applicants respectfully traverse the Examiner's Section 103(a) rejection.

The references, alone or in combination, do not disclose or suggest:

transmitting said transaction data to a remote server of a manufacturer during a transaction session for determination of a possible substitute product to be offered to said consumer

West, like Fraser and Jones, does not address the ability of a manufacturer to determine a possible substitute product to be offered to a consumer during a transaction session.

The newly cited Jones reference is intended to ensure the accurate and timely settlement between manufacturers and the retailers of their products when the manufacturer issues coupons or when the manufacturer agrees to a temporary price reduction in return for retailer support that should lead to increased sales volumes. (col. 4, lines 60 - 67) Jones describes that coupons are normally redeemed by manufacturers of the goods to which the coupons relate. Manufacturers reimburse the retail stores accepting the coupons. (col. 3, lines 30 - 33.) The Jones system conducts an electronic audit for use by manufacturers during settlement. (col. 3, lines 45 - 49) The electronic audit of coupon redemption has safeguards against deliberate or inadvertent misredemption. (col. 4, lines 14 - 17)

Accordingly, Jones has nothing to do with, inter alia, determining possible substitute products.

No Motivation to Combine

PATENT

Application Serial No. 09/221,099
Attorney Docket No. 98-112

Absent hindsight, there is no motivation to combine the references in the manner proposed.

As best as Applicants may ascertain, the stated motivation to select and incorporate portions of the West reference is that West "discloses a point of sale including a terminal having a data reader transaction data [sic], a remote retailer and manufacturer or remote server retailer manufacturer coupon redemption [sic]," and that the combination of West and Eraser would eliminate "the need for the manual collection of data transmission [sic]." (Office Action, page 3, last paragraph to page 4, first paragraph)

As best as Applicants may ascertain, the stated motivation to select and incorporate portions of the Jones reference is that Jones "discloses an audit system that is remotely located from the retail store for receiving processed retail sales transaction data for subsequent use by MANUFACTURER ... which is equivalent to Applicants arguments." (Office Action, page 4, second paragraph)

Neither of the above statements from the Office Action amount to a motivation to select and combine the references in the manner proposed. Accordingly, the record does not show why one of ordinary skill at the time of the invention would have selected the references and combined them in the manner proposed.

Conclusion

For the foregoing reasons it is submitted that all of the claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a three-month extension of time with which to respond to the Office Action. Please charge \$460.00 for this petition to our Deposit Account No. 50-0271.

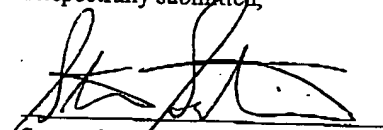
PATENT

Application Serial No. 09/221,099
Attorney Docket No. 98-112

Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



September 9, 2002
Date

Steven Santisi
Attorney for Applicants
Walker Digital, LLC
Registration No. 40,157
Santisi@walkerdigital.com
203-461-7054 / voice
203-461-7300 / fax